



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DPM 01-03

Paper No. 5

R. NEIL SUDOL
COLEMAN SUDOL SAPONE, P.C.
714 COLORADO AVENUE
BRIDGEPORT CT 06605-1601

COPY MAILED

JAN 08 2003

OFFICE OF PETITIONS

In re Application of :
Tullio Gonzaga :
Application No. 09/988,635 : ON PETITION
Filed: 20 November, 2001 :
Attorney Docket No. R23-002 :

This is a decision on the petitions filed under 37 CFR 1.55(c) and 1.183 on 15 July, 2002 (certificate of mailing date 25 June, 2002).

The petition under 37 CFR 1.183 is dismissed.

The petition under 37 CFR 1.55(c) is granted.

Petitioners request waiver of the provisions 37 CFR 1.55(a) and that the Office accept a delayed claim of the benefit of a prior filed foreign application under 35 U.S.C. § 119. Petitioners assert that on 19 November, 2001, an application claiming priority to Italian Patent Application No. VR2000A000115, filed on 20 November, 2000, was deposited in USPS Express Mail to the USPTO, but that the USPS returned the application as undeliverable on 20 November, 2001, because of the temporary suspension of Express Mail Service to Washington, D.C. during November, 2001. Petitioners further explain that the claim of benefit required by 37 CFR 1.55(a)(1) was not timely filed because:

In our haste to prepare a new transmittal, necessitated by the late refusal of the USPS to deliver the application to the PTO, we inadvertently omitted the claim for priority to the Italian Patent Application.

Considered under 37 CFR 1.183, petitioners arguments are not persuasive. 37 CFR 1.183 permits the Commissioner to waive a rule when extraordinary circumstances exist and justice requires waiver of the rule.

37 CFR 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interest party, subject to such other requirements as may be imposed.¹ Petitioner has not shown that either condition exists in this case.

It is well settled that a party's inadvertent failure to comply with the requirements of the rules or procedures before the USPTO is not deemed to be an extraordinary situation that would warrant waiver of the rules or procedures under 37 CFR 1.183.² Waiver of the rules is not warranted when a party makes an avoidable mistake in filing papers.³

That is, a lack of knowledge of, or the failure to properly apply, the patent statutes, rules of practice, and procedures before the USPTO is not an adequate basis for requesting extraordinary relief. Specifically, circumstances resulting from petitioner's, or petitioner's counsel's, failure to exercise due care or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief.⁴ Likewise, clerical inadvertence or error is not a ground for requesting waiver of the regulations.⁵

¹In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

²See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995).

³Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994).

⁴See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

⁵See In re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994).

While the delay in accepting Express Mail, and the extra effort expended by petitioners, is regretted, it is unclear why petitioners chose to claim priority on an application transmittal sheet rather than in the oath or declaration, Application Data Sheet (ADS), or a preliminary amendment. If one of the latter had been done, the predicament which has now occurred could have been avoided because none of those documents would have needed to be revised prior to the second filing of the application papers.

Moreover, although petitioners state that they have been waiting for a substitute declaration signed by the inventor claiming priority to the Italian application, petitioners have not explained why the claim for priority was not timely filed within four (4) months of the filing date of the present application.

In summary, as the showing of record is that the priority claim was not timely filed as a result of petitioners' lack of diligence, the petition under 37 CFR 1.183 will be dismissed.

As the petition under 37 CFR 1.183 is dismissed, the surcharge required for the petition under 37 CFR 1.55(c) will not be refunded.

Petition Under 37 CFR 1.55(c)

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date;
- (3) the surcharge of \$1,280.00, as set forth in 37 CFR 1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the

claim was filed was unintentional. (The Commissioner may require additional information where there is a question whether the delay was unintentional.); and

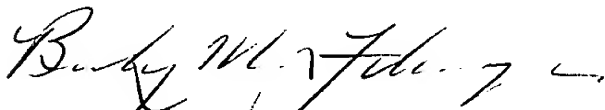
- (5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The above-identified pending nonprovisional application was filed on 20 November, 2001, which is after 29 November, 2000 and within 12 months of 20 November, 2000, which is the earliest filing date of the foreign applications to which benefit is claimed. The Application Data Sheet filed on 18 December, 2002, also identifies the foreign applications for which priority is claimed. Petitioner has also included a statement that the English translation filed with the present petition is a "faithful and true translator (sic) into English" of the Italian application. Pursuant to petitioner's authorization, the \$1,280.00 surcharge has been charged to counsel's deposit account, No. 15-0450. Lastly, petitioner has provided an adequate statement of unintentional delay.

All requirements being met, the petition is **granted**.

This application is being returned to the Office of Initial Patent Examination for issuance of a corrected filing receipt that will include the foreign priority claims and projected publication date for the above-identified application.

Any inquiries directly pertaining to this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (703) 308-6712.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy